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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
NILAND, PATRICK DENNIS	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/525,941
Filing Date: February 28, 2005
Appellant(s): LICHT ET AL.

Charles Wendel
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/26/06 appealing from the Office action mailed 4/19/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 9-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

A. The instant claims recite "by weight" regarding the percentages of the instant claim 9. Claims 10-17 depend from claim 9 and therefore contain this limitation also and are therefore subject to the same rejection. There is not basis seen for the recitation of "by weight". The examples are not commensurate in scope with the instant claims and therefore do not provide basis for the entire scope of the instant claims.

(10) Response to Argument

As background, the claim as originally presented recited no basis for the percentage, e.g. weight, moles, volume, etc. In overcoming the prior 112 second paragraph rejection inquiring what the claimed percentage was based on, the appellant amended the claims to recite "% by weight". It is noted that the claimed percentage would most likely be recited in either percent by weight or mole percent. It could be volume percent but that is not typically used in this situation.

When talking about the amount of "monomers of the polyadduct [that] have reacted to form the polyadduct", one would often use molar percent for the same reasons the equations used in General Organic Chemistry used moles as the quantifiers as well as the same reasons the

appellant uses "mol%" when talking about "polyadduct" reactants at page 6, line 27 of their specification.

Since the "polyadduct" reactions of the instant claims, as shown in the enabling specification, use different reactants of different molecular weights and encompass mixtures of reactants of different reactivity rates, the molar percentage and the weight percentage will often be quite different in real life reactions. The examiner notes that amines are known to react with NCO about 100 times faster than do polyols. See the appellant's specification, page 6, lines18-38 noting that different molecular weight molecules and different functionality molecules and polyamines as well as polyols are encompassed by the disclosure. Each of these differences gives a different reaction rate which will make the weight percent and mole percent for a given reaction different.

The appellant argues in essence that the specification supports the use of "by weight" citing sections relating to the amounts of components used in the composition being referenced by weight percent, e.g. page 8, line 47, page 9, line 18, page 12, line 7, and page 13, line 8. However, none of these sections refer to the claimed percentage, e.g. the amount "of the monomers of the polyadduct [that] have reacted to form the polyadduct." All of the percentages referring to the amount "of the monomers of the polyadduct [that] have reacted to form the polyadduct" are expressed in % and recite no basis for the percent, such as weight, molar, volume, etc.. It is not seen that the amounts referenced in the appellant's arguments as weight percentages are also intended to be basis for the claimed amount "of the monomers of the polyadduct [that] have reacted to form the polyadduct" to be expressed in weight percent. The argument that amounts of reactants consumed in reactions are typically expressed in molar

percentages and the appellant's use of "mol%" at page 6, line 27 to account for amounts of "polyadduct" reactants might equally apply. The appellant has not addressed this issue. Thus, one cannot tell what basis the appellant intended for the claimed limitation of claim 9 at issue in the above rejection. While the specification certainly recites "weight basis", it also recites "mol%" though neither are recited with regard to the limitation in question. Thus, it is not seen that the instant specification supports the claimed amount "of the monomers of the polyadduct [that] have reacted to form the polyadduct" in weight percent or mole percent.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Patrick Niland
Primary Examiner
GAU 1714

Conferees:

Vasu Jagannathan

Romulo Delmendo